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EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2624

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DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/759,462

Applicant(s)

HIBMA, GEERTRUI MARIA  
WILHELMINA

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-17 and 19 is/are rejected.
- 7) ☒ Claim(s) 11 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Detailed Action

1.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear in claims 1 and 6 which of the claimed features allows the customer to interact with the apparatus. The claim language seems to lend itself to software controlling the print operation.

2. Claim 6 is rejected under 35 USC 112 4<sup>th</sup> paragraph. The claim is not further limiting of claim 1. All that is claimed in claim 6, is a reiteration of that already in claim 1.

3. Claims 12, 13, 15 and 16 are rejected under 35 USC 112 2<sup>nd</sup> paragraph, for not providing antecedent for "said server". See line 5 of claim 12. Correction is required.

4.

Claims 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis for "Data carrier".

5. Claims 16 and 19 are rejected under 35 USC 112 6<sup>th</sup> paragraph for failing to provide proper means plus function language .

6.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 6 rejected under 35 U.S.C. 102(a) as being anticipated by Yasumi.

With respect to claim 1, Yasumi teaches a system for distribution of periodical documents (direct mail) to at least one outlet, comprising a server arrangement (second line of the Solution), at least one outlet computer (first line of the Solution) allowing

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communication with a network (second line of the Solution) wherein an electronic copy is comprised in a print format (line 4 of the Solution) and receiving said data comprising the electronic copy of the periodical document from the server arrangement (see line 2 of the Solution); and printing a copy of the periodical document from the electronic copy of the periodical document on request of a customer, see line 8 of the Solution.

With respect to claim 6, Yasumi teaches the server arrangement (according to line 2 of the Solution) as claimed, wherein a copy of the periodical document is sent to an outlet computer (first line of the Solution) wherein the electronic copy (direct mail) comprises the content of the periodical document and information of a predetermined print format (according to mail format, line 2 of the Solution); to receive by said at least one outlet computer arrangement (line 1 of the Solution) said data comprising the electronic copy of the periodical from the server (line 2 of the Solution) and to print (see line 8 of the solution) upon a users request.

7.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yasumi in view of Tognazzini.

Yasumi teaches all of the subject matter as supported by claim 1, but fails to teach the combination of features provided in claim 2.

Tognazzini teaches receiving an electronic copy of a periodical and registers information data from the publishing computer, information data comprising data about an actual edition of the periodical document (such as date sent) and data about a location of the outlet computer (address of the outlet computer), see col. 2, lines 45-54. Furthermore, Tognazzini teaches national language support operations, see element 603 in figure 6 for supporting translations between a first and second language as claimed.

Since Yasumi and Tognazzini are both directed to the transmission and distribution of electronic documents, the purpose of registering unique data about the

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document and providing translational services, would have been recognized by Yasumi as set forth by Tognazzini.

It would have been obvious to one of ordinary skill in the art to modify the software used to run the computer and server, discussed in the Solution, for the purpose of providing the limitations as claimed and supported by Tognazzini.

8. (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by King.

King teaches a server arrangement as provided by in figure 1, comprising: processing means (102) memory means 106 and processor means connected to the memory and arrangement to communicate with publishing computers (108, 110, 112) and at least one outlet computer (which is one of the other computers mentioned above

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not chosen as the publishing computer) wherein the processing means performs as follows:

to send data comprising the electronic copy as claimed wherein the electronic copy comprises the content of the periodical document and information of a predetermined format, (i.e., the PDL format col. 2, lines 47-55).

9.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 12 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tognazzini.

With respect to claim 12, Tognazzini teaches an outlet computer arrangement (PC in figure 6) for distribution of a periodical document, comprising processing means (620) memory means (810 in figure 8a) a printer (840) in figure 8b, said processing means connected to the memory as claimed ; said at least one outlet computer arrangement to



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communicate with a server (620) for receiving an electronic copy including the content of the periodical document; and a printer (600 according to figure 6) for the purpose claimed.

With respect to claim 17, Tognazzini teaches a computer program product, (such as card type language selectors 260 shown by figure 2, flash memory 210, according to figure 2 and memory means inherently provided in the translation service 630 of the the software for running the network 620). The computer product sends information regarding comprising processing means (620) memory means (810 in figure 8a) a printer (840) in figure 8b, said processing means connected to the memory as claimed ; said at least one outlet computer arrangement to communicate with a server (620) for receiving an electronic copy including the content of the periodical document; and a printer (600 according to figure 6) for the purpose claimed.

#### 10. Claims Objected as Containing Allowable Subject Matter

Claims 3-5, 8, 9, 11, 13, 15 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Certain of the above claims, if amended to include the limitations of the base claim and corrected to overcome the 112 rejections above, would be allowed.

11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Jerome Grant II from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore, can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JEROME GRANT II  
PRIMARY EXAMINER

J. Grant II

Nov. 28, 2002